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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,910	03/26/2004	Julio J. Hernandez	60021-379701	9393
29838 7590 07/25/2008 OPPENHEIMER WOLFF & DONNELLY, LLP PLAZA VII, SUITE 3300 45 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-1609				
EXAMINER				
PARKER, BRANDI P				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,910

Applicant(s)

HERNANDEZ ET AL.

Examiner

BRANDI P. PARKER

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 9/21/2006, 10/27/2005, 7/7/2008.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 1-35 are pending in this Office Action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claim 1 is directed to defining and storing prioritized experiences. Therefore, as the claims are not sufficiently tied to an apparatus, such as a computer, and/or do not transform the underlying subject matter (from your claim) to a different state the claimed method is non-statutory and therefore rejected under 35 U.S.C. 101. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Whether a method appropriately includes particular machines to qualify as a section 101 process may not always be a straightforward inquiry. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable

subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (BPAI 2008-1495, 2008).

5. Moreover, with respect to claims 1, 13 and 25, the claims recite a method, computer program stored on a medium and a system for defining and storing prioritized experiences without creating a tangible result. The tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result. *Gottschalk v. Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."), MPEP 2105 IV C 2 (2) b.

6. Claims 2-12, 14-24 and 26-35 are rejected for being dependent upon rejected claims 1, 13 and 25 respectively.

Claim Objections

7. Regarding claims 5-11, 17-23, and 31-34, a claim which depends from a dependent claim should not be separated by any claim which does not also depend

from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

8. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 12 is a method depending from subsequent claim 21. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3623

10. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkinson et al (US 7016936).

11. With respect to claims 1, 13 and 25, Wilkinson teaches a method for defining how to optimize customer experiences, the method comprising:

- a. defining a plurality of prioritized experiences correlating to an interaction strategy, wherein each prioritized experience has at least one associated treatment (column/line 6/1-14);

- b. storing the plurality of prioritized experiences for consistent treatment among a plurality of channels (Figure 1, item 15);

- c. wherein the step of storing is done to a central repository where the stored experiences are available for application across a plurality of communication channels (column/line 10/41-48; Figure 1, item 15).

12. As to claims 2, 14 26, Wilkinson teaches the method from claim 1, further comprising: evaluating a customer strategy for a company (column/line 6/15-18); identifying a plurality of customer segments for a customer base of a company; and formulating an interaction strategy based on value opportunities (column/line 6/32-38).

13. Regarding claims 3-4, 15-16 and 27-28, Wilkinson teaches wherein the step of deriving insight from analytical models comprises:

- d. extracting customer data for a plurality of customers from at least one database (column/line 11/59-67);
- e. training analytical models to predict customer behavior, wherein analytical model is trained using the customer data extracted from at the east one database (column/line 6/66-7/12; 14/4-13);
- f. gathering the customer interaction results (column/line 7/2-5); and
- g. retraining analytic model to refine the customer behavior prediction, wherein analytical model is re-trained using the customer data extracted from at least one database as well as the customer interaction results (column/line 7/10-19, 14/15-28).

14. As to claims 5 and 17, Wilkinson teaches the method from claim 2, wherein evaluating the customer strategy comprises: evaluating business value drivers; defining key performance indicators; and defining business constraints (column/line 6/15-18).

15. Regarding claims 6, 18 and 29, Wilkinson teaches the method from claim 2, wherein identifying the plurality of customer segments comprises: segmenting a plurality

of customers by behavior data stored in a data warehouse; segmenting the plurality of customers by value data stored in a data warehouse; and generating a two-dimensional matrix for cross-segmenting the plurality of customers by both behavior data and value data (column/line 14/4-13).

16. With respect to claims 7, 19 and 30, Wilkinson teaches the method from claim 2, wherein formulating the interaction strategy comprises choosing a subset of interaction reasons from a pre-defined repository of interactions for a specified industry (column/line 12/46-57, specific conditions that can be tailored to a specific industry).

17. As to claims 8, 20 and 31, Wilkinson teaches the method from claim 2, wherein the step of formulating the new interaction strategy comprises capturing current channel mix for all experiences and future channel mix for prioritized experiences (column/line 10/6-23).

18. Regarding claims 9, 21 and 32, Wilkinson teaches the method from claim 2, wherein the step of formulating the interaction strategy comprises modeling value opportunities (column/line 14/4-13).

19. With respect to claims 10, 22 and 33, Wilkinson teaches the method from claim 2, wherein formulating the interaction strategy comprises ranking interaction reasons to determine a primary set of interaction reasons (column/line 5/61-67).

20. As to claims 11, 23 and 34, Wilkinson teaches the method from claim 2 wherein formulating the interaction strategy comprises:

- h. defining a plurality of treatments (column/line 5/55-61); and
- i. assigning each of the plurality of the plurality of treatments to a prioritized interaction (column/line 6/15-23).

21. Regarding claims 12, 24 and 35, Wilkinson teaches the method from claim 21, wherein the step of assigning is based on a hierarchy of grouped rules (column/line 5/61-67).

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nizzari et al (US 6014647, system for tracking customer interactions), Siefert (US 6047261, method and system for monitoring and enhancing the performance of the user interaction), Katz (US 6055513, method and system for obtaining commercial information through user interaction), Walter et al (US 6334110), Vincent (US 2002/0087385, system and method for suggesting interaction strategies)

and Carr et al (US 20030220901, customer interaction manager) Beck et al (US 6230197, method and apparatus for rules based storage and retrieval of multimedia interactions).

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3623

/BRANDI P PARKER/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623